

#6

PATENT
Attorney Docket No. 212691

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Zaleski et al.

Art Unit: Unassigned

Application No. 09/913,924

Examiner: Unassigned

Filed: August 20, 2001

For: COMPOUNDS, COMPOSITIONS, AND
METHODS FOR PHOTODYNAMIC
THERAPY

**RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C.
371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

Commissioner for Patents
Washington, D.C. 20231

Dear Sir

Applicants hereby respond to the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) dated October 16, 2001.

The Notification states that the Oath or Declaration of the inventors filed with the application on August 20, 2001, does not comply with 37 CFR 1.497 (a) and (b) in that it is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68, and that two inventors are listed on the Declaration while only one inventor is listed on the international application No. PCT/US00/04915 (a copy of the front page of the international publication WO 00/50117 accompanied the Notification).

The undersigned hereby verifies that Jeffrey M. Zaleski and Diwan Singh Rawat are the inventors in the international patent application No. PCT/US00/04915. A Request Under PCT Rule 92^{bis} to add the name of Diwan Singh Rawat as an applicant/inventor was timely filed with the International Bureau of WIPO on August 17, 2001, and was recorded by the International Bureau of WIPO, which is evidenced by a Notification of the Recording of a Change. Because both inventors properly executed the Combined Declaration and Power of Attorney, which was submitted with the application, it is believed that a new Combined Declaration and Power of Attorney and a \$65.00 surcharge are not required.

As all 35 U.S.C. 371 requirements were fulfilled at the time of filing of the application, it is also believed that the filing date of this patent application should remain August 20, 2001.

Furthermore, a statement regarding the sequence listing issue is also enclosed herewith. In short, the application does not include a disclosure of nucleotide and/or amino acid sequences, and, hence, no written or computer readable sequence listing is necessary and the application is complete.

In re Appln. of Zaleski et al.
Application No. 09/913,924

The items checked below are appropriate:

1. Status of Applicants

This application is on behalf of ☐ other than a small entity or ☒ a small entity.

2. Documents Submitted Herewith

- a. ☒ Copy of Notification of Mission Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)
- b. ☒ Copy of the front page of the international publication WO 00/50117
- c. ☒ Copy of Request Under PCT Rule 92^{bis}
- d. ☒ Copy of the executed PCT Power of Attorney from Jeffrey M. Zaleski and Diwan Singh Rawat
- e. ☒ Copy of the Notification of the Recording of a Change from the International Bureau of WIPO
- f. ☒ Statement Regarding Sequence Listing

3. Extension of Time

☐ Applicants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$110.00.

☒ Applicants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicants have inadvertently overlooked the need for a petition and fee for extension of time.

Fee Due: \$0.00

4. Total Fee Due

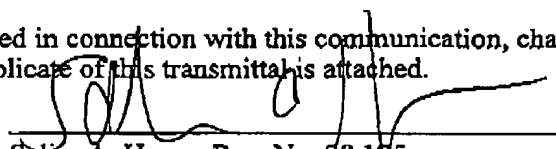
The total fee due is:

Extension of Time Fee \$ 0.00

Total Fee Due: \$0.00

6. Fee Deficiency

☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216. A duplicate of this transmittal is attached.


Satim A. Hasan, Reg. No. 38,175
One of the Attorneys for Applicant(s)
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: December 6, 2001

Anna SAH Page 1 of 2

☒ Commissioner For Patents, Box PCT, United States Patent and Trademark Office, Washington, D.C. 20231, www.uspto.gov

U.S. APPLICATION NUMBER NO.

09/913,924

FIRST NAMED APPLICANT

Zaleski

ATTY. DOCKET NO.

212691

INTERNATIONAL APPLICATION NO.

PCT/US00/04915

I.A. FILING DATE

02/25/2000

PRIORITY DATE

02/26/1999

23460

LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6780

CONFIRMATION NO. 5503

371 FORMALITIES LETTER

OC000000006907638

Date Mailed: 10/16/2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated Office (37 CFR 1.494):

- U.S. Basic National Fees
- Indication of Small Entity Status
- Priority Document
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Information Disclosure Statements
- Oath or Declaration
- Preliminary Amendments
- Request for Immediate Examination
- Small Entity Statement

LEYDIG, VOIT & MAYER
RECEIVED

OCT 22 2001

PAT/TM Due Date

12.16.2001
Final - 5.16.2002

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
 - is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
- \$65 Surcharge for providing the oath or declaration later than the appropriate 20 months from the priority date (37 CFR 1.492(e)) is required.

DNG

LAH

- The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):
 - A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
 - APPLICANT MUST PROVIDE:
 - An Initial or substitute computer readable form (CRF) of the "Sequence Listing."
 - A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).
- For questions regarding compliance to 37 CFR 1.821-1.825 requirements, please contact:
 - For Rules Interpretation, call (703) 308-4216
 - To Purchase PatentIn Software, call (703) 306-2600
 - For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTH FROM THE DATE OF THIS NOTICE OR BY 22 or 32 MONTHS (where 37 CFR 1.496 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

SUMMARY OF FEES DUE:

Total additional fees required for this application is \$65 for a Small Entity:

- \$65 Late oath or declaration Surcharge.

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

BARBARA A CAMPBELL

Telephone: (703) 305-3631

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
09/913,924	PCT/US00/04915	212691

Agent's Reference 203955

IN THE INTERNATIONAL BUREAU OF WIPO

International Application No. PCT/US00/04915	International filing date (day/month/year) 25.02.00	(Earliest) Priority date (day/month/year) 26.02.99
Title of invention COMPOUNDS, COMPOSITIONS, AND METHODS FOR PHOTODYNAMIC THERAPY		
Applicant(s) ADVANCED RESEARCH AND TECHNOLOGY INSTITUTE, INC. et. al.		

REQUEST UNDER PCT RULE 92th

International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20
Switzerland

COPY

Dear Sir,

Please record the following change in the indication for the inventors appearing in Box No. III of Form PCT/RO/101:

Please add the following inventor:

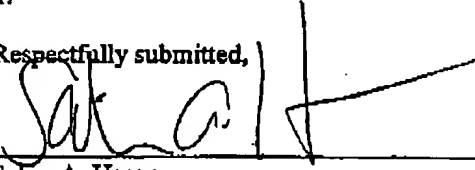
RAWAT, Diwan Singh
316 E, Apt. 19, University
Bloomington, Indiana 47401
US

This person is an applicant and inventor.

A new PCT Power of Attorney executed by both applicants (Jeffrey M. Zaleski and Diwan Singh Rawat) is attached hereto. In order to expedite this matter, this request is being sent by facsimile with a confirmation copy via DHL Courier.

Respectfully submitted,

By


Salim A. Hasan
Agent for the Applicant
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 Telephone
(312) 616-5700 Facsimile

August 17, 2001

Attorney Docket No. 212691

International Application No. PCT/US00/04915
International Filing Date: 25 February 2000
Priority Date Claimed: 26 February 1999

CERTIFICATE OF FACSIMILE TRANSMISSION

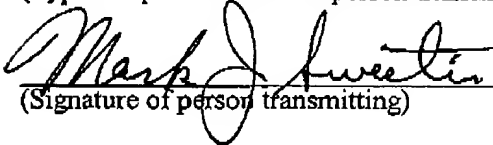
I hereby certify that this SUBMISSION OF COPIES OF THE RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS FILED DECEMBER 6, 2001, (along with any documents referred to as attached or enclosed) is being transmitted by facsimile to the PCT Division, United States Patent and Trademark Office, Facsimile Number 703-746-6705, on the date indicated.

Attached:

1. Submission of Copies of the Response to Notification of Missing Requirements Filed December 6, 2001 (2 pgs.)
2. Copy of Transmittal Letter to the DO/EO/US Concerning a Filing Under 35 U.S.C. 371 with Certification under 37 C.F.R. § 1.10. (3 pgs.)
3. Copy of Notification of Missing Requirements Under 35 U.S.C. 371 (2 pgs.)
4. Copy of Response to Notification of Missing Requirements Under 35 U.S.C. 371 (2 pgs.)
5. Copy of Front Page of WO 00/50117 (1 pg.)
6. Copy of Request dated August 17, 2001, Under PCT Rule 92^{bis} requesting that Diwan Singh Rawat be added to the application as an inventor and Executed PCT Power of Attorney (1 pg.)
7. Copy of Form PCT/IB/306 recording the addition of Diwan Singh Rawat as an inventor (1 pg.)
8. Copy of Statement Regarding Sequence Listing (1 pg.)
9. Copy of Express Mail Receipt dated December 6, 2001

Date: 1-16-03Mark J. Sweetin


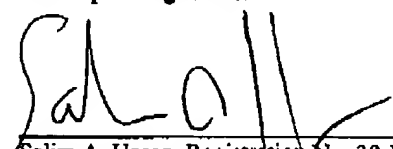
(Typed or printed name of person transmitting)



(Signature of person transmitting)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTORNEY DOCKET NO. 212691
TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 USC 371 AND 37 CFR 1.491		U.S. APPLICATION NO. 09/913,924
INTERNATIONAL APPLICATION NO. PCT/US00/04915	INTERNATIONAL FILING DATE 25 FEBRUARY 2000 (25.02.00)	PRIORITY DATE CLAIMED 26 FEBRUARY 1999 (25.02.99)
TITLE OF INVENTION COMPOUNDS, COMPOSITIONS, AND METHODS FOR PHOTODYNAMIC THERAPY		
APPLICANT(S) FOR DO/EO/US ZALESKI, Jeffrey M.; RAWAT, Diwan Singh		
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:		
1. <input type="checkbox"/> This is a FIRST submission of items concerning a filing under 35 USC 371 and 37 CFR 1.491.		
2. <input checked="" type="checkbox"/> This is a SECOND or SUBSEQUENT submission of items concerning a filing under 35 USC 371 and 37 CFR 1.491.		
3. <input type="checkbox"/> This is an express request to begin national examination procedures (35 USC 371(f)).		
4. <input type="checkbox"/> The US has been elected by the expiration of 19 months from the priority date (PCT Article 31).		
5. <input type="checkbox"/> A copy of the International Application as filed (35 USC 371(c)(2)) <ul style="list-style-type: none"> a. <input type="checkbox"/> is attached hereto (required only if not communicated by the International Bureau). b. <input type="checkbox"/> has been communicated by the International Bureau. c. <input type="checkbox"/> is not required, as the application was filed in the United States Receiving Office (RO/US). 		
6. <input type="checkbox"/> An English language translation of the International Application as filed (35 USC 371(c)(2)).		
7. <input type="checkbox"/> Amendments to the claims of the International Application under PCT Article 19 (35 USC 371(c)(3)) <ul style="list-style-type: none"> a. <input type="checkbox"/> are attached hereto (required only if not communicated by the International Bureau). b. <input type="checkbox"/> have been communicated by the International Bureau. c. <input type="checkbox"/> have not been made; however, the time limit for making such amendments has NOT expired. d. <input type="checkbox"/> have not been made and will not be made. 		
8. <input type="checkbox"/> An English language translation of the amendments to the claims under PCT Article 19 (35 USC 371(c)(3)).		
9. <input type="checkbox"/> An oath or declaration of the inventor(s) (35 USC 371(c)(4)).		
10. <input type="checkbox"/> An English language translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 USC 371(c)(5)).		
11. Nucleotide and/or Amino Acid Sequence Submission <ul style="list-style-type: none"> a. <input type="checkbox"/> Computer Readable Form (CRF) b. Specification Sequence Listing on: <ul style="list-style-type: none"> i. <input type="checkbox"/> CD-ROM or CD-R (2 copies); or ii. <input type="checkbox"/> Paper Copy c. <input type="checkbox"/> Statement verifying identity of above copies 		
Items 12 to 19 below concern other document(s) or information included:		
12. <input type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98. <ul style="list-style-type: none"> <input type="checkbox"/> Form PTO-1449 <input type="checkbox"/> Copies of Listed Documents 		
13. <input type="checkbox"/> An assignment for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.		
14. <input type="checkbox"/> A FIRST preliminary amendment. <input type="checkbox"/> A SECOND or SUBSEQUENT preliminary amendment.		
15. <input type="checkbox"/> A substitute specification.		
16. <input type="checkbox"/> A change of power of attorney and/or address letter.		
17. <input type="checkbox"/> Application Data Sheet Under 37 CFR 1.76		
18. <input checked="" type="checkbox"/> Return Receipt Postcard		
19. <input checked="" type="checkbox"/> Other items or information: Response to Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US); Copy of Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US); Copy of Front Page of International Publication WO 00/50117; Copy of Request Under PCT Rule 92 bis and Executed PCT Power of Attorney; Copy of Notification of the Recording of a Change from International Bureau of WIPO; Statement Regarding Sequence Listing		

EL190835423US

U.S. APPLICATION NO. 09/913,924		INTERNATIONAL APPLICATION NO. PCT/US00/04915		ATTORNEY DOCKET NO. 212691	
20. <input type="checkbox"/> The following fees are submitted: Basic National Fee (37 CFR 1.492(a)(1)-(5)): Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO and International Search Report not prepared by the EPO or JPO \$1,040.00 International preliminary examination fee (37 CFR 1.482) not paid to USPTO but International Search Report prepared by the EPO or JPO \$ 890.00 International preliminary examination fee (37 CFR 1.482) not paid to USPTO, but international search fee (37 CFR 1.445(a)(2)) paid to USPTO \$ 740.00 International preliminary examination fee paid to USPTO (37 CFR 1.482) but all claims did not satisfy provisions of PCT Article 33(1)-(4) \$ 710.00 International preliminary examination fee paid to USPTO (37 CFR 1.482) and all claims satisfied provisions of PCT Article 33(1) to (4) \$ 100.00				CALCULATIONS	PTO USE ONLY
ENTER APPROPRIATE BASIC FEE AMOUNT=				\$	
Surcharge of \$130.00 for furnishing the National fee or oath or declaration later than <input type="checkbox"/> 20 <input type="checkbox"/> 30 months from the earliest claimed priority date				\$	
CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE		
Total Claims	-20=		x \$ 18.00	\$	
Independent Claims	- 3 =		x \$ 84.00	\$	
<input type="checkbox"/> Multiple Dependent Claim(s) (if applicable)				+\$280.00	\$
TOTAL OF ABOVE CALCULATIONS=				\$	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by 1/2.				\$	
SUBTOTAL=				\$	
Processing fee of \$130.00 for furnishing English Translation later than <input type="checkbox"/> 20 <input type="checkbox"/> 30 months from the earliest claimed priority date.				\$	
TOTAL NATIONAL FEE=				\$	
Fee for recording the enclosed assignment. The assignment must be accompanied by an appropriate cover sheet. \$40.00 per property				+	\$
TOTAL FEE ENCLOSED=				\$0.00	
				Amount to be refunded	\$
				charged:	\$
a. <input type="checkbox"/> A check in the amount of \$ to cover the above fee is enclosed. b. <input type="checkbox"/> Please charge Deposit Account No. 12-1216 in the amount of \$ to cover the above fees. A duplicate copy of this sheet is enclosed. c. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 12-1216. A duplicate copy of this sheet is enclosed.					
NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status.					
SEND ALL CORRESPONDENCE TO: Customer Number: 23460					
 23460 PATENT TRADEMARK OFFICE			 Salim A. Hasan, Registration No. 38,175 One of the Attorneys for Applicant(s)		
			Date: December 6, 2001		


U.S. APPLICATION NO. 09/913,924	INTERNATIONAL APPLICATION NO. PCT/US00/04915	ATTORNEY DOCKET NO. 212691
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CERTIFICATION UNDER 37 CFR 1.10

"Express Mail" Label Number: EL190835423US

Date of Deposit: December 6, 2001

I hereby certify that this express request to begin national examination procedures under 35 USC 371(f) of the International Patent Application referenced above, including all of the items listed thereon as enclosures, is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated above and is addressed to U.S. Patent and Trademark Office, Box PCT, Attention: DO/EO/US, P.O. Box 2327, Arlington, VA 22202.

Irina Mikitiuk 

Printed Name of Person Signing: Signature

7LAW OFFICES
LEYDIG, VOIT & MAYER, LTD.
TWO PRUDENTIAL PLAZA SUITE 4 00
CHICAGO, ILLINOIS 60601-6780

WWW.LEYDIG.COM

F A X T R A N S M I T T A L

Date: January 16, 2003	Agent's Reference:	212691
In re Appln. of: Zaleski et al.	International Application No.	PCT/US00/04915
Application No. 09/913,924	International Filing Date:	25 February 2000
Number of pages (including this transmittal cover sheet): 17	Priority Date Claimed:	26 February 1999

To: Attention: Barbara Campbell
PCT Division
Commissioner for Patents
Washington, DC 20231

From: Salim A. Hasan, Reg. No. 38,175
Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza
Suite 4900
Chicago, IL 60601-6780

Office Telephone: (703) 305-3631

Office Telephone: (312) 616-5600

Facsimile Number: (703) 746-6705

Facsimile Number: (312) 616-5700

Message:

A confirmation copy of the transmitted document will:

- Not be sent. This will be the only form of delivery of the transmitted document.
 - Be sent via First Class/Air Mail.
 - Be sent via Overnight Courier
-

The information contained in this facsimile transmission is intended only for the use of the individual or entity named above and those properly entitled to access to the information and may contain information that is privileged, confidential, and/or exempt from disclosure under applicable law. If the reader of this transmission is not the intended or an authorized recipient, you are hereby notified that any unauthorized distribution, dissemination, or duplication of this transmission is prohibited. *If you have received this transmission in error, please immediately notify us by telephone or facsimile. Thank you.*

PATENT
Attorney Docket No. 212691**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Zaleski et al.

Art Unit: Unassigned

Application No. 09/913,924

Examiner: Unassigned

Filed: August 20, 2001

For: COMPOUNDS, COMPOSITIONS, AND
METHODS FOR PHOTODYNAMIC
THERAPY**SUBMISSION OF COPIES OF THE RESPONSE TO NOTIFICATION OF MISSING
REQUIREMENTS FILED DECEMBER 6, 2001**Attn: Barbara Campbell
PCT Division
U.S. Patent and Trademark Office
Washington, D.C. 20231

Dear Ms. Campbell

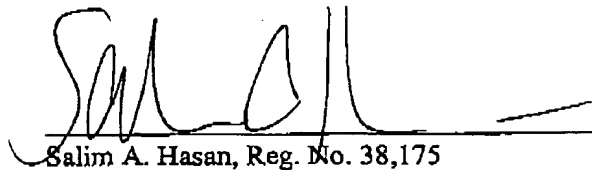
Applicants assert that the documents listed below were in fact deposited with the DO/EO/US on December 6, 2001, in response to the Notification Of Missing Requirements Under 35 U.S.C. 371. In support of Applicants' assertion, attached herewith are true copies of the documents deposited on December 6, 2001:

1. Copy of Transmittal Letter to the DO/EO/US Concerning a Filing Under 35 U.S.C. 371 with Certification under 37 C.F.R. § 1.10.
2. Copy of Response to Notification of Missing Requirements Under 35 U.S.C. 371.
3. Copy of Front Page of WO 00/50117.
4. Copy of Request dated August 17, 2001, Under PCT Rule 92^{bis} requesting that Diwan Singh Rawat be added to the application as an inventor and Executed PCT Power of Attorney.
5. Copy of Form PCT/IB/306 recording the addition of Diwan Singh Rawat as an inventor.
6. Copy of Statement Regarding Sequence Listing.
7. Copy of Express Mail Receipt dated December 6, 2001

Furthermore, the above documents verify that all 35 U.S.C. 371 requirements were fulfilled at the time of filing of the application. Therefore, it is believed that the filing date of this patent application should remain August 20, 2001.

In re Appln. of Zaleski et al.
Application No. 09/913,924

Respectively submitted,

A handwritten signature in black ink, appearing to read 'Salim A. Hasan', is written over a horizontal line.

Salim A. Hasan, Reg. No. 38,175
One of the Attorneys for Applicant(s)
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: January 16, 2003